

LAW OFFICES  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005

Telephone  
(202) 408-4000

Facsimile  
(202) 408-4400

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To: Wan Laymon  
Firm: USPTO Petitions Office  
Fax No.: (703) 872-9306 Phone No.: (703) 305-9285  
Reissue Application No. 09/099,048  
Subject: Atty. Doc. 09481.0004-01000 Date: May 6, 2004


From: William L. Strauss Phone No.: 202-408-4185  
Fax # Verified by: WLS No. of Pages (incl. this page) 31

Confirmation Copy to Follow: No

Message:

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that the attached papers, "Letter" and "Petition to Suspend the Rules Under 37 C.F.R. § 1.183 or to Be Accorded Status Under 37 C.F.R. § 1.47(A)," are being transmitted by facsimile to the U.S. Patent and Trademark Office on the above-identified date.

  
William L. Strauss  
Reg. No. 47,114

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PATENT  
Customer Number 22,852  
Attorney Docket No. 09481.0004-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Laurette Nacamulli et al. )  
Reissue Application No.: 09/099,048 ) Group Art Unit: 1641  
Filed: June 17, 1998 ) Examiner: M. E. Ceperley  
For: RATE MEASUREMENTS OF )  
BIOMOLECULAR REACTIONS USING )  
ELECTROCHEMILUMINESCENCE )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

LETTER

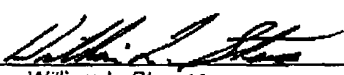
It has come to the attention of the undersigned that the Petition to Suspend the Rules Under 37 C.F.R. §1.183 or to Be Accorded Status Under 37 C.F.R. § 1.47(a) dated April 27, 2004, was inadvertently filed unsigned. Applicants hereby submit a duly executed version of the Petition, which is dated May 5, 2004, and respectfully request its entry and consideration.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2004

By:   
William L. Strauss  
Reg. No. 47,114

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PATENT CENTRAL FAX CENTER  
Customer Number 22,852  
Attorney Docket No. 09481.0004-01000  
MAY 06 2004

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

OFFICIAL

In re Application of: )  
Laurette Nacamulli et al. )  
Reissue Application No.: 09/099,048 ) Group Art Unit: 1641  
Filed: June 17, 1998 ) Examiner: M. E. Ceperley  
For: RATE MEASUREMENTS OF )  
BIOMOLECULAR REACTIONS )  
USING )  
ELECTROCHEMILUMINESCENCE )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION TO SUSPEND THE RULES UNDER 37 C.F.R. §1.183**  
**OR TO BE ACCORDED STATUS UNDER 37 C.F.R. § 1.47(a)**

Applicants hereby petition the Commissioner to suspend the rules regarding the requirement for the signature of all joint inventors on a supplemental Reissue Declaration and Power of Attorney.

United States Patent Application No. 08/347,984 (the "984 application"), now United States Patent No. 5,527,710 (the "710 patent"), was filed on December 2, 1994, naming Laurette Nacamulli, Jonathan K. Leland, and Stephanie Hayes as inventors. Each of the inventors assigned their rights to the '984 application to IGEN, Inc. ("IGEN"). The '710 patent issued on June 18, 1996.

On June 17, 1998, the above-identified reissue application was filed in order to broaden the scope of the claims in the '710 patent. The reissue declaration was filed on

Application No. 09/099,048  
Attorney Docket No. 09481.0004-01000

June 17, 1998, and was signed by two of the three joint inventors of the '984 application, i.e., Jonathan K. Leland and Stephanie Hayes. A first Petition to Suspend the Rules Under 37 C.F.R. § 1.183 detailing the attempts of Barry Evans, IGEN's patent attorney at the time, to obtain the signature of the missing inventor, Laurette Nacamulli, was mailed to the U.S. Patent and Trademark Office (the "Office") on October 29, 1998. A copy of that document is attached to this Petition as Exhibit A. On September 28, 1999, the Office granted Applicants' first Petition and accorded Rule 1.47(a) status to this application.

In an *Ex parte* Quayle Action mailed October 28, 2003, the Examiner required a supplemental declaration in accordance with M.P.E.P. § 1415. On February 23, 2004 Ms. Tanya Sell of the BioVeris Corporation<sup>1</sup> sent a supplemental declaration to Ms. Laurette Nacamulli at her last known address. See Declaration of Tanya Sell (the "Sell Declaration"), ¶ 6. On February 26, 2004 the envelope containing the supplemental declaration was returned to Ms. Sell by the United States Postal Service. See *id.*, ¶ 7. Copies of the letter, the supplemental declaration, and the envelope showing the return to sender stamp are attached to the Sell Declaration.

35 U.S.C. § 116 dictates how the remaining inventors may pursue an application despite their inability to find or reach a joint inventor after diligent effort. It states, in pertinent part:

If a joint inventor ... cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the

<sup>1</sup> On February 12, 2004 IGEN assigned the '710 patent to the BioVeris Corporation. See Recordation of Assignment filed concurrently herewith.

Application No. 09/099,048  
Attorney Docket No. 09481.0004-01000

inventor making the application subject to the same rights  
which the omitted inventor would have had if he had been  
joined.

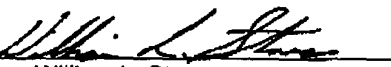
By virtue of Mr. Evans' and Ms. Sell's attempts to reach Ms. Nacamulli to obtain  
her signature on the Reissue Declaration and Power of Attorney and the supplemental  
Reissue Declaration and Power of Attorney, Applicants submit that a diligent effort has  
been made to contact Ms. Nacamulli.

In view of the foregoing remarks and exhibits, it is respectfully submitted that  
Applicants have complied with 35 U.S.C. § 116 and 37 C.F.R. § 1.183. Therefore,  
Applicants request that the Commissioner suspend the rules in this instance and allow  
the Applicants to pursue the above-identified reissue application without the signature of  
Ms. Nacamulli on the supplemental Reissue Declaration and Power of Attorney.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2004

By:   
William L. Strauss  
Reg. No. 47,114

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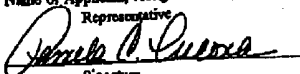
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant(s) : Nacamulli et al.  
Serial No. : 09/099,048  
Reissue of : U.S. Patent No. 5,527,710  
Filed : June 17, 1998  
For : RATE MEASUREMENTS OF BIOMOLECULAR  
REACTANTS USING ELECTROCHEMILUMINESCENCE  
Group Art Unit : 1641  
Examiner : NOT YET ASSIGNED

200 Park Avenue  
New York, New York 10166

I hereby certify that his correspondence  
is being deposited with the United States  
Postal Service as first class mail in an  
envelope addressed to:  
Assistant Commissioner for Patents  
Washington, D.C. 20231, on October 29, 1998

Pamela C. Ancona, Reg. No. 41,494  
Name of Applicant, Assignee or Registered  
Representative  
  
Signature

October 29, 1998  
Date of Signature

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MAY 14 2004

OFFICE OF PETITIONS

**PETITION TO SUSPEND THE RULES  
UNDER 37 C.F.R. §1.183**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to suspend  
the rules regarding the requirement for the signature of all  
joint inventors on a Reissue Declaration and Power of Attorney.

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Enclosed herewith is a check in the amount of \$130.00 to cover the petition fee set forth in 37 C.F.R. § 1.17.

U.S. Application Serial No. 08/347,984 (the "'984 application"), now U.S. Patent No. 5,527,710, was filed on December 2, 1994, naming Laurette Nacamulli, Jonathan K. Leland, and Stephanie Hayes as inventors. At the time of filing, each of the inventors were employees of IGEN, Inc. and they assigned their rights to the '984 application to IGEN, Inc. Subsequently, Laurette Nacamulli left her position at IGEN, Inc. and she provided no forwarding address. Shortly thereafter, the '984 application issued as U.S. Patent No. 5,527,710 (on June 18, 1996).

After issuance, the patent was reviewed and it was determined that the issued claims did not provide protection for the entire scope of the invention. Specifically, the patent claimed less than the inventors had a right to claim, such that the patent failed to claim a method for determining the time course of a reaction and method for determining the concentration of a reactant.

Thus, the above-identified reissue application was filed on June 17, 1998 in order to broaden the scope of the claims in U.S. Patent No. 5,527,710. The reissue declaration was filed on June 17, 1998 and was signed by two of the three joint

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Reissue Application of U.S. Patent No. 5,527,710  
Serial No.: 09/099,048  
Group Art Unit: 1641  
Examiner: NOT YET ASSIGNED

PATENT  
KM39091-70

inventors of the '984 application, i.e., Jonathan K. Leland and Stephanie Hayes.

On June 16, 1998, the undersigned attempted to contact Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, using her last known address. A copy of that letter is enclosed as Exhibit A. When no response was received, a second letter was sent via registered mail on September 22, 1998 and a return receipt was requested. On September 24, 1998 the letter was returned to the undersigned, indicating on the envelope that the forwarding order expired, i.e. that Ms. Nacamulli no longer resided at that address and mail sent to that address was no longer being forwarded to her at her new address. Copies of the letter, return receipt, and envelope showing the return to sender stamp are enclosed as Exhibit B.

35 U.S.C. § 116 dictates how the remaining inventors may pursue an application despite their inability to find or reach a joint inventor after diligent effort. It states, in pertinent part:

If a joint inventor . . . cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the

-3-

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Reissue Application of U.S. Patent No. 5,527,710  
Serial No.: 09/099,048  
Group Art Unit: 1641  
Examiner: NOT YET ASSIGNED

PATENT  
KM39091-70

application, subject to the same rights which the omitted inventor would have had if he had been joined.

By virtue of the undersigned's attempts to reach Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, Applicants submit that a diligent effort has been made to contact Ms. Nacamulli.

Therefore, in view of the foregoing remarks and exhibits, it is respectfully submitted that Applicants have complied with 35 U.S.C. §§ 116 and 37 C.F.R. § 1.183. Therefore, Applicants request that the Commissioner suspend the rules in this instance and allow Applicants to pursue the above-identified reissue application without the signature of Ms. Nacamulli on the Reissue Declaration and Power of Attorney.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment resulting from this petition to Deposit Account No. 50-0297.

Respectfully submitted,

WHITMAN BREED ABBOTT & MORGAN, LLP  
Attorneys for Applicants

By: 

Barry Evans  
Reg. No. 22,802  
John E. Boyd  
Reg. No. 38,055  
Pamela C. Ancona  
Reg. No. 41,494  
(212) 351-3000

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